

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

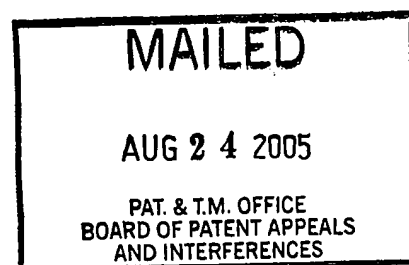
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte DANIEL M. JUDGE

Appeal No. 2005-1260
Application No. 10/068,078

HEARD: August 9, 2005



Before FRANKFORT, MCQUADE, and NASE, Administrative Patent Judges.
FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 3, 5 through 7, 15 through 18, 20, 21 and 23 through 28. Claims 8, 19 and 22, the only other claims remaining in the application, stand objected to as being dependent upon a rejected base claim, but have been indicated to be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. Claims 1, 2, 4 and 9 through 14 have been cancelled.

As noted on page 1 of the specification, appellant's invention relates to rolled products having contiguous separable sheets, and particularly to such rolled products that are marked with indicia that provide an easily observable visual indication of the outer most end of the roll of separable sheets, and to a method for making such a marked roll of contiguous separable sheets. Independent claims 3, 5, 15 and 20 are representative of the subject matter on appeal and a copy of those claims can be found in the Appendix to appellant's brief.

The references of record relied upon by the examiner to reject the claims on appeal are:

Clayton et al. (Clayton)	4,076,121	Feb. 28, 1978
Thomason	4,195,787	Apr. 1, 1980
Kildune	5,266,257	Nov. 30, 1993
Hollenberg et al. (Hollenberg)	6,221,211	Apr. 24, 2001
Johnson	6,282,807	Sep. 4, 2001

Claims 3 and 5 through 7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Thomason:

Claims 15 through 18, 20, 21, 23, 24 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson in view of Thomason.

Claim 25 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson in view of Thomason as applied to claim 20 above, and further in view of Clayton.

Claim 27 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson in view of Thomason as applied to claim 20 above, and further in view of Hollenberg.

Claim 28 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson in view of Thomason as applied to claim 20 above, and further in view of Kildune.

Rather than reiterate the conflicting viewpoints advanced by appellant and the examiner regarding the above-noted rejections, we refer to the final rejection (mailed March 19, 2004) and the answer (mailed December 2, 2004) for a complete exposition of the examiner's position, and to appellant's brief (filed August 26, 2004) for the arguments thereagainst.

OPINION

Having carefully reviewed the anticipation and obviousness issues raised in this appeal in light of the record before us, we have made the determinations which follow.

Regarding the examiner's rejection of claims 3 and 5 through 7 under 35 U.S.C. § 102(b) based on Thomason, we note that the Thomason patent addresses the same problem confronted by appellant and discloses (e.g., in Fig. 4) a rolled product, such as bathroom tissue, having contiguous separable sheets wherein at least first and second contiguous separable sheets of product are marked with indicia (14') that provides an easily observable visual indication of the beginning or outer most free end of the roll of contiguous separable sheets, and wherein the indicium is in the form of an undulating indicium extending continuously over at least the first and second contiguous separable sheets of product.

In response to the anticipation rejection, appellant has argued that Thomason does not disclose "the continuous undulating indicium over the length of the roll" (brief, page 6) and thus does not anticipate the claimed subject matter. Appellant has additionally urged that Thomason does not disclose the plurality of "continuous indicium that extend over the length of the roll."

Like the examiner, we note that claims 3 and 5 through 7 on appeal do not require a continuous undulating indicium extending “over the length of the roll,” as has been argued by appellant. Instead, these claims merely set forth that the indicium is on at least first and second contiguous sheets of the product roll and that the indicium is in the form of a continuous undulating indicium, which subject matter is clearly shown in Thomason Figure 4. Moreover, if the four sheets seen in Thomason Figure 4 having the continuous undulating indicium (14') thereon were the last four contiguous sheets left on the roll, then even the rolled product as now argued by appellant would appear to be anticipated by Thomason.

In light of the foregoing, we will sustain the examiner’s rejection of claims 3 and 5 through 7 under 35 U.S.C. § 102(b) based on Thomason.

The next rejection for our review is that of claims 15 through 18, 20, 21, 23, 24 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Johnson in view of Thomason. In this instance, the examiner has determined that it would have been obvious to one of ordinary skill in the art at the time of appellant’s invention to add perforations to the rolled product disclosed by Johnson to replace the serrated edge (18) so the rolled product would be formed of contiguous separable sheets, as taught by Thomason, in order that the rolled product be more convenient for the user because

they can more easily tear off only as much product as needed without the risk of cutting themselves on the serrated edge or blade. Concerning dependent claims 16 through 18, the examiner has additionally concluded that it would have been obvious to one of ordinary skill in the art to use sinusoid-shaped marks which are out of phase with one another, as taught by Thomason, instead of the mark disclosed by Johnson, in order that the product be more visually appealing while ensuring that a user will be able to see the indicating mark.

The essence of appellant's response to the examiner's rejection under 35 U.S.C. § 103(a) based on the combined teachings of Johnson and Thomason is set forth on page 9 of the brief, and reads as follows:

We have shown above that the secondary reference fails to disclose the limitation in all these claims calling for the visually perceivable mark extending the length of each of the sheets continuously for the entire length of the roll, and the primary reference fails to overcome this shortcoming. The primary reference is concerned with indicating the balance of a continuous roll, not the beginning of a roll of sheets. It is thus impossible to combine the primary and secondary references to meet the terms of claims 15-18, 20, 21, 23, 24 and 26.

We find this line of argument unpersuasive. In the first place, the primary reference to Johnson does disclose or suggest the limitation in claims 15 and 20 on appeal regarding a visually perceivable mark extending the length of each of the sheets continuously for the entire length of the roll. In that regard, we point to Figure 2 of

Johnson and the fact that the mark on the contiguous separable bags or sheets of the rolled product therein may be in the form of a continuous diagonal line (26) extending along the entire length of the rolled product, or in the form of an embossed indicia applied in an intermittent pattern (126) as shown in Figure 2. Clearly, the embodiment of Figure 2 with a continuous diagonal line (26) extending along the entire length of the rolled product would be fully responsive to the subject matter on appeal as represented by independent claims 15 and 20. Concerning the requirement in certain of the claims on appeal that the mark be undulating or sinusoid-shaped, we point to Figure 4 of Thomason showing an undulating or sinusoid-shaped decorative marking line (14') and the disclosure in Johnson (col. 4, lines 37-39) indicating that whether continuous or intermittent, the indicia therein may embody a fanciful design, which teachings collectively in our view render the above-noted subject matter obvious within the meaning of 35 U.S.C. § 103. As for the fact that the main concern in Johnson is with indicating the balance of a continuous roll of product, not the beginning of a roll of sheets, we find such argument to be of no moment, since the continuous diagonal line (26) extending along the entire length of the rolled bag or sheet product suggested by Johnson would inherently provide an indication like that set forth in the claims on appeal when the rolled product is outside the dispenser or when the free end of the rolled product falls into the dispenser after removing a previous sheet or bag, and would facilitate finding the beginning or free end of the roll of contiguous sheets or bags due to

the offset or discontinuity “likely formed between the mark at any sheet edge and the portion of the mark which lies directly beneath the edge on the roll,” as required in appellant’s independent claims 15 and 20.

Concerning appellant’s bare assertion that there is nothing in the references which suggests the desirability of combining what is there to meet the terms of the rejected claims (brief, page 10) and the assertion that even if combined in the manner proposed by the examiner, that which is set forth in the claims on appeal would not result (brief, page 9), we find such assertions to be unpersuasive because appellant has provided no explanation to support them and no reasoning as to why the applied references are not combinable as urged by the examiner and, if combined, why the combination would not meet the claims on appeal as determined by the examiner. Moreover, it appears to us that Johnson itself would have been suggestive of the combination posited by the examiner. Note particularly column 1, lines 36-44, of Johnson wherein it is noted that the rolled web products described therein may be formed of paper and supplied “in single or multi-ply sheet configuration” (emphasis added). See also column 3, lines 13-20 of Johnson. Moreover, column 1, lines 48-51, specifically note that the rolled products may typically be dispensed from a container, which may be provided with a serrated cutting edge or, alternatively, that “perforations may be provided laterally across the web.”

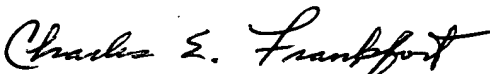
As a result of the foregoing evaluation of the collective teachings of Johnson and Thomason, we will sustain the examiner's rejection of claims 15 through 18, 20, 21, 23, 24 and 26 under 35 U.S.C. § 103(a).

The last of the examiner's rejections for our review are of claims 25, 27 and 28 under 35 U.S.C. § 103(a) as being unpatentable over Johnson, Thomason and Clayton (claim 25), Johnson, Thomason and Hollenberg (claim 27) and Johnson, Thomason and Kildune (claim 28). In each instance, appellant has not argued the examiner's use of the tertiary reference in the rejection, but has instead merely urged that the claim under review is dependent upon and includes all of the limitations of claim 20, and that the reasons set forth for claim 20 are submitted to support the patentability of the respective dependent claims. Given our disposition of independent claim 20 above, we find appellant's arguments regarding dependent claims 25, 27 and 28 to be unpersuasive. Moreover, concerning claims 25 and 28, we note that the sheets in Johnson (Fig. 2) are disclosed as or suggested to be plastic bags and that Johnson expressly indicates that the marks therein are embossed on the sheets (col. 4, lines 5-7). Finding no meaningful argument from appellant regarding the separate patentability of claims 25, 27 and 28, we will sustain the examiner's rejection of those claims under 35 U.S.C. § 103(a).

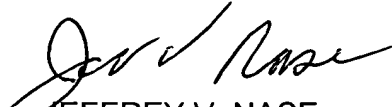
In accordance with the foregoing discussions, the decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED


CHARLES E. FRANKFORT
Administrative Patent Judge


JOHN P. MCQUADE
Administrative Patent Judge


JEFFREY V. NASE
Administrative Patent Judge

)
)
)
)
)
) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES
)
)
)
)
)

Appeal No. 2005-1260
Application No. 10/068,078

Page 11

FISH & RICHARDSON PC
225 FRANKLIN ST
BOSTON, MA 02110